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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,706	03/29/2004	Akihiko Shimasaki	KPC-0309	9050

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EXAMINER

CAMERON, ERMA C

ART UNIT PAPER NUMBER

1762

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,706

Applicant(s)

SHIMASAKI ET AL.

Examiner

Erma Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 8, 11, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 9-10, 13-14, 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Specification

1. The objection to the disclosure because of informalities is withdrawn because of the amendment filed 5/22/2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6, 9-10, 13-14 and 16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The following subject matter is not well defined and described:

a) Page 56: it is not clear why only one of the Japanese applications that are claimed as priority are mentioned on page 56.

4. The rejection of Claims 6-7, 9-10 and 20-21 under 35 U.S.C. 112, first paragraph (“substrate”), is withdrawn because of the amendment filed 5/22/2006.

5. Claims 6 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a film or coated article that is based on the base resins as given in claim 14, does not reasonably provide enablement for a base resin of amino-epoxy resin alone. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Page 1, line 21 to page 2, line 13 teach that the amino-epoxy resin of JP 2000-007960 is not satisfactory to the applicant. Therefore, it appears that only one of the base resins of claim 14 will give satisfactory results in the claimed invention.

This was not addressed in the 5/22/2006 amendment.

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6. Claims 6, 9-10, 13-14 and 16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following is new matter introduced in the 5/22/2006 amendment:

a) The chemical structure of page 13, lines 10-16 is not the same as the structure as filed (the original had OH near the middle, not O).

b) Table 1 and 2: \neq = parts by weight in terms of resin content.

(No support for this is given.)

c) Table 1: definitions of MDI-PG and MDI-OX. No support is given.

d) Table 3-2: “*” is used now for two different purposes – to define parts by weight, and to designate 2-8 (tests defined on pages 53-58).

The applicant is requested to cancel new matter.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 13: ~~strikethrough~~ makes it appear that the new range is -1 to -9.

Specification

9. The amendment filed 5/22/200 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a) The chemical structure of page 13, lines 10-16 is not the same as the structure as filed (the original had OH near the middle, not O).

b) Table 1 and 2: ~~✱~~ = parts by weight in terms of resin content.

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(No support for this is given.)

c) Table 1: definitions of MDI-PG and MDI-OX. No support is given.

d) Table 3-2: “*” is used now for two different purposes – to define parts by weight, and to designate 2-8 (tests defined on pages 53-58).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

10. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 19 does not further limit claim 14 on which it is dependent. Independent claim 13 now claims a bismuth compound.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. The rejection of Claims 6 and 13 under 35 U.S.C. 102(a) as being clearly anticipated by the admitted state of the prior art is withdrawn because of the amendment filed 5/22/2006.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. The rejection of Claims 6 and 13 under 35 U.S.C. 102(b) as being clearly anticipated by JP 2000-007960 is withdrawn because of the amendment filed 5/22/2006.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The rejection of Claims 6-7, 9-10, 13-14, 16-18 and 20 under 35 U.S.C. 103(a) as being unpatentable over JP 2003-306796 is withdrawn because of the amendment filed 5/22/2006.

17. The rejection of Claim 19 and 21 under 35 U.S.C. 103(a) as being unpatentable over JP 2003-306796 taken in view of Nishiguchi et al (6492027) is withdrawn because of the amendment filed 5/22/2006.

18. The rejection of Claim 19 and 21 under 35 U.S.C. 103(a) as being unpatentable over JP 2003-306796 taken in view of EP 1111013 is withdrawn because of the amendment filed 5/22/2006.

19. The rejection of Claims 6-7, 9-10, 13-14 and 16-21 under 35 U.S.C. 103(a) as being unpatentable over EP 1314768 is withdrawn because of the amendment filed 5/22/2006.

Double Patenting

20. The rejection of Claim 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 6734260 is withdrawn because of the amendment filed 5/22/2006.

21. The rejection of Claims 6-7, 9-10, 13-14 and 16-21 under 35 U.S.C. 103(a) as being obvious over Nishiguchi et al (6734260) is withdrawn because of the amendment filed 5/22/2006.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

August 7, 2006